

## REMARKS/ARGUMENTS

### *Status of Claims*

Claim 1 has been amended.

Claims 6 and 18-33 have been canceled.

Thus, claims 1-5, 7-17 and 34-36 are pending in this patent application.

Applicants hereby request further examination and reconsideration of the presently claimed application.

### *35 USC § 112 Rejections*

The August 31, 2006 Office Action (hereinafter the “Office Action”) rejected claim 35 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement because claim 35 purportedly contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time of the application was filed, had possession of the claimed invention. Specifically, the Office Action contends that “[t]here is no support in the specification for the limitation wherein the additive hydrolyses is less than about 1 hour.” *See* Office Action at 2.

First, “*ipsis verbis*” disclosure is not necessary to satisfy the written description of requirement of section 112 . . . [i]nstead, the disclosure need only reasonably convey to persons skilled in the art that the inventor had possession of the subject matter in question.” *See Fujikawa v. Wattanasin*, 93 F.3d 1559, 1570 (Fed. Cir. 1996). Second, “[t]here is a strong presumption that an adequate written description of the claimed invention is present when the application is filed.” *See* MPEP § 2163 (citing *In re Wertheim*, 541 F.2d 257, 263 (CCPA 1976) (“we are of the opinion that the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure the description of the invention defined by the claims”)). Applicants respectfully disagree with the Office Action’s conclusion that claim 35 lacks sufficient

disclosure in the specification and offer the following textual support for claim 35's limitation that "the additive hydrolyses is less than about 1 hour":

[0024] The static filtration test was performed in the same manner as described in Comparative Example 1 except that the HTHP cell was kept under pressure only for 30 minutes. The filtrate volume was measured to be *1.4 mL after 30 minutes*. A filter cake having a uniform thickness of about 1 mm was formed. *The fluid removed from the HTHP cell appeared to be similar to the original OBM.*

[0025] A filter cake removal test was then performed by placing approximately 200 mL of a mixture of BROMIMUL invert emulsion fluid containing 10 weight % OSA by weight of the fluid in the HTHP cell containing the residual OBM filter cake. Nitrogen pressure (500 psig) was again applied to the HTHP cell. The subsequent fluid loss and cleanup characteristics of the above mixture were observed. The volume of mixture that had passed through the porous ceramic disc *after 60 minutes* was measured to be *8.2 mL*. *The fluid removed from the HTHP cell appeared to be translucent and amber in color.* The filter cake appeared to become loose and delaminated during this time. It was also entrained with gas bubbles such that its appearance was similar to rising bread dough, *indicating acid dissolution of the calcium carbonate particles contained within the OBM filter cake.*

See Application ¶¶ [0024]-[0025] (emphasis added). Based on the above, Applicants contend that the specification contains a sufficient disclosure of claim 35's limitation "wherein the additive hydrolyses is less than about 1 hour" to meet the strictures of 35 U.S.C. § 112, first paragraph.

### ***Claim Rejections – 35 U.S.C. § 102***

Claims 1-5, 7-9, 12-15, 33 and 36 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Harris, et al. WO 01/02698 (hereinafter "*Harris*").

The Applicants respectfully submit that *Harris* does not establish a *prima facie* case of anticipation as to the amended claims. According to MPEP § 2131, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." The Applicants have amended claim 1 to include the limitation that "the hydrolysis occurs substantially in the absence of a catalyst." This amendment

merely incorporates the limitations of the former dependant claim 33 into the newly amended claim 1.<sup>1</sup> Applicants respectfully submit that, not only does *Harris* not expressly teach such a limitation, but that *Harris* teaches away from the instant Application's claims. See *In re Kahn*, 441 F.3d 977, 990 (Fed. Cir. 2006) ("A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." (quoting *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994) (internal quotation marks omitted))).

*Harris* specifically teaches that "[e]ster hydrolysis in the absence of catalysis proceeds slowly . . . the hydrolysis may take several weeks . . . [t]he treatment fluids used in the method of the present invention will normally require . . . a maximum of 7 days but normally less than 3 days." See *Harris* at 6, lines 20-27. *Harris* goes on to teach that it is "essential to the method of the present invention to use a non-enzyme catalyst to hydrolyse the ester." See *Harris* at 7, lines 7-10 (emphasis added). Furthermore, *Harris* explicitly claims, "[a] method for treating an underground reservoir, which method comprises introducing into the reservoir a treatment fluid comprising, dissolved or dispersed in water, an ester and a non-enzyme catalyst capable of increasing the rate of hydrolysis of the ester . . . ." See *Harris* at 18, claim 1 (emphasis added) (the remainder of the *Harris* claims incorporate the elements of claim 1 by reference). Clearly, *Harris* expressly teaches away from the instant invention's teaching that "the hydrolysis occurs substantially in the absence of a catalyst." See *supra* at 2. Accordingly, *Harris* does not anticipate amended claim 1, nor claims 2-5, 7-9, 12-15, and 36 which are dependant on amended claim 1. Based on the foregoing, as currently presented, claims 1-5, 7-9, 12-15, and 36 are allowable.

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<sup>1</sup> Applicants respectfully traverse the Office Action's rejection of claim 33 based on a determination that *Harris* "discloses that the hydrolysis occurs substantially in the absence of a catalyst." See Office Action at 4-5 (citing *Harris* at 6, lines 19-24). As will be discussed *infra*, *Harris* actually teaches away from hydrolysis without catalysis.

***Claim Rejections – 35 U.S.C. § 103***

Claims 10, 11 and 34 stand rejected over 35 USC § 103(a) as being unpatentable over *Harris* in view of *Patel*, et al., U.S. Patent No. 5,888,944 (hereinafter “*Patel*”). Claims 16 and 17 stand rejected as being unpatentable over *Harris* in view of *Parlar*, et al., U.S. Patent No. 6,631,764 (hereinafter “*Parlar*”).

The Office Action has failed to establish a *prima facie* case of obviousness because the combination of *Harris* in view of *Patel* and *Harris* in view of *Parlar* fail to teach or suggest all of the claim limitations of the instant Application.<sup>2</sup> Claims 10, 11, 16, 17 and 34 each depend from and incorporate the limitations of independent claim 1 as discussed previously. Neither *Patel* nor *Parlar* teach or suggest the limitation of amended claim 1, “the hydrolysis occurs substantially in the absence of a catalyst.” *See supra* at 2. Additionally, as noted above, *Harris*, does not disclose each and every element of independent claim 1. Thus, Applicants respectfully submit that claims 10, 11, 16, 17 and 34 are patentable over the combinations of *Harris* and *Patel* and *Harris* and *Parlar*.

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<sup>2</sup> Applicants do not concede that that the combinations of *Harris* and *Patel* and *Harris* and *Parlar* are proper and reserve their right to contest the validity of the Office Action’s combinations. *See* MPEP § 2143 (“The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not the applicant’s disclosure.” (citing *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991))).

### CONCLUSION

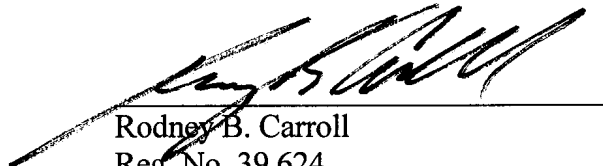
Consideration of the foregoing amendments and remarks, reconsideration of the application, and withdrawal of the rejections and objections is respectfully requested by Applicants. No new matter is introduced by way of the amendment. It is believed that each ground of rejection raised in the Office Action dated August 31, 2006 has been fully addressed. If any fee is due as a result of the filing of this paper, please appropriately charge such fee to Deposit Account Number 50-1515 of Conley Rose, P.C., Texas. If a petition for extension of time is necessary in order for this paper to be deemed timely filed, please consider this a petition therefore.

If a telephone conference would facilitate the resolution of any issue or expedite the prosecution of the application, the Examiner is invited to telephone the undersigned at the telephone number given below.

Respectfully submitted,

CONLEY ROSE, P.C.

Date: 11-29-06

  
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